

**REMARKS/ARGUMENTS**

Claims 1, 8, and 10 have been amended to clarify previously described material or to incorporate additional material previously contained in the as-filed claims. New claims 21-29 likewise contain previously disclosed material from the as-filed patent and claims. No new matter has been added.

The Office Action mailed May 16, 2005, has been received and reviewed. Claims 1 through 20 are currently pending in the application. Claims 1 through 20 stand rejected. Applicants have amended claims 1, 8, and 10, have canceled claims 7 and 13-20, have added new claims 21-29, and respectfully request reconsideration of the application as amended herein.

**Objections to Claims**

Claims 10, 16, and 19 were objected to because of writing informalities. Claim 10 has been amended herein as requested by the Examiner. Claims 16 and 19 have been canceled.

**35 U.S.C. § 102(e) Anticipation Rejections**

Anticipation Rejection Based on U.S. Patent Application Publication No. 2003/0184785 to Guddanti

Claims 1 through 6, 9, 10, and 12 through 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Guddanti (U.S. Patent Application Publication No. 2003/0184785). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 has been amended to include recitation of reading said (external to the housing of the image-forming device) bar code information with an image-forming device controller and updating the image-forming device settings upon activation or resetting of the image-forming device. New independent claim 29 requires prompting a user to pass said the bar code over said bar code reader when said image-forming device senses an open

tray, as recited in pending claim 11. Pending claims 2-6, 9, 10, and 12 all depend from and contain all of the limitations of amended claim 1.

As acknowledged by the Examiner, Guddanti does not disclose “updating the printer settings upon activation or resetting of the printer or when the media tray is opened.” (Office Action at pages 3-4). In view of the foregoing amendments and arguments, Applicant respectfully requests withdrawal of the anticipation rejections to the pending claims.

### 35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent Application Publication No. 2003/0184785 to Guddanti in View of PCT International Publication No. WO 01/81093 A2 to Prenn

Claims 7, 8, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Guddanti (U.S. Patent Application Publication No. 2003/0184785) in view of Prenn (PCT International Publication No. WO 01/81083 A2). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

As previously discussed, independent claim 1 has been amended to include recitation of reading said (external to the housing of the image-forming device) bar code information with an image-forming device controller and updating the image-forming device settings upon activation or resetting of the image-forming device. New independent claim 29 requires prompting a user to pass said the bar code over said bar code reader when said image-forming device senses an open tray. Claim 8 has been amended to include all of the limitation of previously pending claim 1 so as to make it an independent claim. Claim 8 requires reading said bar code information with an image-forming device controller and updating the image-forming device settings when said media tray is opened or changed.

As acknowledged by the Examiner, Guddanti does not disclose, teach or suggest “updating the printer settings upon activation or resetting of the printer or when the media tray is opened” and further does not disclose, teach or suggest reading said bar code information with an image-forming device controller and updating the image-forming device settings when said media tray is opened or changed, as required by amended claim 8.

Prenn is relied upon as disclosing “a printer comprising updating the printer settings upon activation or resetting of the printer or when the media tray I opened.” (Office Action at page 4).

With reference to independent claims 1, 8, and 29, there is no suggestion or motivation stated in the cited references to modify or combine the teachings therein to obtain the present invention. Additionally, even if such motivation or suggestion to combine were found, all of the claim limitations are not found in the combined references.

As previously discussed, independent claims 1, 8, and 29 require sensing information encoded in said bar code with a bar code reader located external to a housing of the image-forming device and reading bar code information with an image-forming device controller. Prenn does not teach or suggest providing a bar code reader external to a housing of an image-forming device. In fact, Prenn teaches away from that concept, as it expressly requires that the bar code reader be located within the tray that accepts the print media. Because of this configuration for the bar reader, the print media is further required to be designed in a partial package to permit introduction of the packaged media into the tray with the bar reader, and to further allow the media to exit the package while in the tray. The present invention overcomes all of these shortcomings, as described in the Background section, at paragraph [0006], of the present application.

As previously discussed, claims 1 and 8 also require updating the image-forming device settings upon activation or resetting of the image-forming device, or when said image-forming device senses an open tray. Claim 29 further requires prompting a user to pass said the bar code over said bar code reader when said image-forming device senses an open tray. However, there is no teaching or suggestion in Guddanti or Prenn, either alone or in combination, to prompt a user to pass said the bar code over said bar code reader when said image-forming device senses an open tray. Additionally, there is no teaching or suggestion in Guddanti or Prenn, either alone or in combination, to update the image-forming device after

the user is either prompted to pass the bar code over the bar code reader (which is located externally to the media tray), or upon sensing an open tray or being reset after the user has already passed the bar code over the externally located bar code reader.

All of the remaining, pending claims depend from and contain all of the limitations of independent claims 1, 8, and 29.

In view of the foregoing amendments, Applicant respectfully requests reconsideration and withdrawal of the obviousness rejections.

#### **ENTRY OF AMENDMENTS**

The amendments to claims 1, 8 and 10 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

#### **CONCLUSION**

Claims 1-6, 8-12, and 21-29 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



Edgar R. Cataxinos  
Registration No. 39,931  
Attorney for Applicant(s)  
TRASKBRITT  
P.O. Box 2550  
Salt Lake City, Utah 84110-2550  
Telephone: 801-532-1922

Date: August 16, 2005

ERC/ps:jm

Document in ProLaw